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10/696,584	10/30/2003	Hiroyuki Nagano	4686-002	9438
23429 7590 09/30/2008 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314				
EXAMINER				
YOO, JASSON H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,584

Applicant(s)

NAGANO, HIROYUKI

Examiner

Jasson H. Yoo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/12/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 11 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-11, 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- _____ Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- _____ Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The amendment filed 6/12/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant's original specification does not disclose the pins are located proximate to a shoulder. The amendment disclose "the pins are located proximate a shoulder (no numeral) in a manner illustrated in Fig. 8". Fig. 8 does not explicitly nor implicitly illustrate a shoulder. It is not clear what the shoulder (non numeral) element is referred to in the figure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's original disclosure fails to teach of a shoulder between the upper narrowed portion and the lower enlarged portion.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/696,594 in view of Vogt et al. (US 5,556,809). Claims 1 and 2 of copending Application 10/696,594 incorporates all the current claim limitations by specifically describing the limitation of the guide part with a mounting member. Claim 2 of Application 10/696,594 specifically describes the partition members. Application 10/696,594 incorporates all the claim limitation except for a container. The current invention is directed to a gaming machine for separating foreign matter such as liquid, from a bill. In an analogous art to separating foreign matter from money entering a machine, Vogt discloses a container (12 in Fig. 3) for storing foreign matter that has

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been separated from the money. Providing a container vertically below the guide part would collect and store the liquid that has been discharged by the guide part. The container would prevent the collected liquid from entering the bill processor and other parts of the gaming machine. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify the claimed invention and incorporate a container disposed at a rear face of the door and below the guide part, in order to collect and store the foreign matter, and prevent the foreign matter from entering the bill processor and other parts of the gaming machine.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-11, 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parish et al (US 5,156,250) in view of Vogt et al (US 5,566,809).

Claims 1, 14. Parish discloses a currency receiver for use within a vending machine. The vending machine comprising:

a cabinet (physical component of the vending machine (col. 2:48-49),

a door provided on a front face of the cabinet (col. 2:49-52, and Fig. 1),

a bill insertion slot provided in the door (Figs. 1-2); and

a bill guide plate provided on the door and extending forward from a lower end of the bill insertion slot for guiding a bill into the bill insertion slot (bottom guide part 82, See Figs. 1-2), wherein the bill guide plate has a plurality of openings for dropping foreign matter separated from the bill (apertures shown in Figs. 3-7 and described in col. 3:20-60), and partition members arranged within the openings for partitioning each of the openings into a plurality of small openings (ribs shown in Figs. 3-7 and described in col. 3:20-60).

Parish discloses a bill receiver to prevent customer tampering, vandalism, and malfunction of a vending machine (col. 1:21-41). Parish discloses that the currency receiver can be used in any vending machine that accepts currency (col. 2:40-52). Parish discloses that liquid sometimes can enter the mechanisms of the vending machine and cause malfunction to occur and the liquid diverter/bill guide is provided for purposes of redirecting liquid/foreign matter outwardly away from the bill validator and vending machine (cols. 1:35-40, 2:63-3:4). However, Parish fails to disclose a guide part positioned under the openings of the bill guide plate for guiding the foreign matter dropped from said openings downwards, and a container disposed at a rear face of the door and below the guide part for collecting the foreign matter. Nevertheless, in an analogous art to bill guides, Vogt discloses a guide part positioned under the openings of the bill guide plate for guiding the foreign matter dropped from said openings downwards (As shown in Fig. 1, the bottom portion of the bill validator 120 is a guide part positioned under the openings of the bill guide plate for guiding the foreign matter

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downwards), and a container disposed at a rear face of the door and below the guide part for collecting the foreign matter (12 in Fig. 3). The container vertically below the guide part would collect and store the liquid that has been discharged by the guide part. The container would prevent the collected liquid from entering the bill processor and other parts of the gaming machine. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the claimed invention and incorporate a container disposed at a rear face of the door and below the guide part, in order to provide a predictable result of collecting and storing the foreign matter, and preventing the foreign matter from entering the bill processor and other parts of the gaming machine.

Claim 2. Parish in view of Vogt discloses the gaming machine an upper opening of the container is positioned substantially vertically below the guide part (as noted above) and has a larger cross-sectional area than a lower end part of the guide part (Vogt discloses the opening of the container is larger than the lower end of the bill validator 120, See Fig. 1).

Claims 3, 11. Parish in view of Vogt discloses the container is detachably mounted to the rear face of the door (Vogt discloses the container is located at the front portion of the machine. The container is detachable using fasteners 38, col. 3:51-60).

Claim 4. Parish in view of Vogt discloses the container has a rectangular horizontal cross-section, and one of long sides of the rectangular cross-section faces the rear face of the door when the container is mounted to the door (Vogt, Fig. 2).

Claim 5. Parish in view of Vogt discloses the claimed invention as discussed above, but fails to specifically teach the container is formed of a substantially transparent or semi-transparent material. Nevertheless, having the container made from transparent or semi-transparent material is an obvious design change. Parish in view of Vogt discloses the container collects foreign matter such as liquid. Having a transparent or semi-transparent container will provide a visual indication to tell the operator when the container is filled, and what is inside the container. This commonly practiced for liquid holding containers (i.e. water bottles, milk cartons, soda bottles, etc.). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Parish in view of Vogt's gaming machine and have the container substantially transparent or semi-transparent material in order to provide a visual indication.

Claim 6. Parish in view of Vogt discloses gaming machine that separates foreign matter from a bill and collects the foreign matter in a container as discussed above, but fails to specifically teach the container is one liter or less. However, the specific size of the container is a design change and does not functionally alter the gaming machine that separates the foreign matter from a bill and collects the foreign matter as discussed

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above. The size of the container may vary depending on the amount of space the gaming machine has for the container. Furthermore, bills are not substantially absorbent material, and cannot carry a large amount of foreign matter such as liquid at a time. Thus it is not efficient to put a very large container within a gaming machine that would take up a large amount of space within the container, when the container collects only a small amount of foreign matter. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Parish in view of Vogt's gaming machine, and have the container's storage capacity to one liter or less, in order to provide an efficient container size for the gaming machine.

Claim 7. Parish in view of Vogt discloses a bill validator (Parish 60 in Fig. 2; Parish 120 in Fig. 1).

Claim 8. Parish in view of Vogt discloses the bill validator is configured to validate the authenticity and quality of the bill guided by the bill guide plate (Parish, bill validator 60 inherently validates the authenticity and quality of the bill; Parish 120 in Fig. 1).

Claims 10, 18. Parish in view of Vogt discloses the container is detachably mounted to the rear face of the door as discussed above, but fails to teach the gaming machine further comprises two latches are provided on the rear surfaces of the door; and two pins for detachably engaging the latches protruding from two side faces of the container. Nevertheless, the specific method of attaching the container to the door is a

design choice. The latches allow the parts to be removed from the gaming machine, for maintenance purposes. By using the latches and pins to detachably mount the container onto the door, the gaming operator can easily remove the container from the door by disengaging the latches from the pins. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Parish in view of Vogt's gaming machine and have the container mounted to the rear face of the door using latches and pins, in order to provide the predictable result of easily removing and attaching the container from the door using fastening mechanisms within the gaming machine.

Claim 13. Parish in view of Vogt discloses a coin slot in the door (Parish, 30 in Fig. 1) that is different from the bill insertion slot (Parish 10 in Fig. 1).

Claim 15. Parish in view of Vogt discloses the guide part is fixed immovably to the door [As discussed in claim 1 above, Parish discloses a door containing a bill insertion slot. Vogt discloses a guide part is fixed to the front part of the machine, to direct liquid to the container (Vogt, Fig. 1). When modifying Parish invention with a door containing a bill insertion slot to incorporate Vogt guide part to direct liquid to a container, one of ordinary skill in the art would have known how to modify the invention accordingly and have the guide part fixed to the door so that the guide part can guide the foreign matter from the bill insertion slot.].

Claim 16. Parish in view of Vogt discloses the claimed invention as discussed above but fails to teach the container comprises an upper narrowed portion and a lower enlarged portion having a completely closed bottom. Nevertheless such design changes that do not impact the function of system cannot be relied on to distinguish the claimed subject matter over prior art. In this case, the claimed subject matter of a container having an upper narrowed portion and a lower enlarged portion having a completely closed bottom is a design choice and does not functionally alter the protective system suggested by Parish view of Vogt in which foreign matter is separated from the bill in order to protect the gaming machine from the foreign matter. Providing a container with a narrow opening invention will prevent liquid from splashing out of the container (i.e. a soda bottle, or a milk bottle). This will further prevent the liquid from entering components of the machine. A container having a lower enlarged portion will allow more foreign matter to be collected (i.e. a soda bottle or a milk bottle). A completely closed bottom will eliminate the need for a drain, and the foreign matter will simply be stored in the container. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Parish in view of Vogt container and incorporate an upper narrowed portion and a lower enlarged portion having a completely closed bottom in order to provide predictable results of preventing liquid from splashing out of the container, collecting more foreign matter and eliminate the need for a drain.

Furthermore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Parish in view of Vogt and incorporate a certain

shape of container since the court held that changing the shape of an invention involves only routine skill in the art. *In re Daily*, 149 USPQ 47.

Claim 17. Parish in view of Vogt discloses the container is detachably mounted to the door in a vicinity of a shoulder between the upper narrowed portion and the lowered enlarged portion. It is noted that this limitation is interrupted as the container is mounted to door, and a shoulder piece is in vicinity (or near) the upper narrowed portion and lowered enlarged portion. This limitation does not structurally define what the shoulder is, what function the shoulder piece provides for the container, nor does not define where the shoulder is structurally located in respect to the container. Any piece of gaming machine within the machine can be considered in vicinity of between the upper narrowed portion and the lower enlarged portion. (For example, consider a point between the upper narrowed portion and the lower enlarged portion as point "A". Any piece within the gaming machine that forms a shoulder is in the vicinity of point "A" because the shoulder piece is within the gaming machine.) The Examiner interprets the shoulder is lower part of Fig. 1 (Vogt.) in which the container's overhanging ends 24 is attached to (Vogt, col. 3:40-50). The shoulder piece supports the overhanging ends 24.

Claim 19 and 20. Parish in view of Vogt discloses the partition members are configured to prevent a coin usable with the gaming machine from passing through the small openings of the bill guide plate and being collected in the container. Referring to Parish, Figs. 3-4 and 10, the slot opening (102, 104) lengths are smaller than the

diameter of a coin, and prevents a coin usable with the gaming machine and collected in the container.

Claim 21. Parish in view of Vogt discloses the bill guide plate has an open bottom part that has an inclined peripheral wall [When incorporating with Vogt's guide part and container, the bill guide plate must have an opening to pass liquid into the container. Furthermore Parish discloses the walls are inclined (side walls 84).]; and the guide part also has an open bottom part (shown in Fig. 1 to dispense liquid) that also has an inclined peripheral wall (side walls shown in Fig. 1).].

Claim 22. Parish discloses a bill validator within the cabinet (Figs. 1 and 8). Although Parish fails to explicitly state that the bill validator is entirely enclosed within the cabinet it can be assumed that the bill validator is entirely enclosed within the cabinet (according to Figs. 1 and 8) or would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the position of the bill validator to be entirely enclosed within the cabinet since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 23. Parish in view of Vogt discloses the gaming machine wherein an upper side of the bill guide plate (upper side of the lower plate 82 in Parish Fig. 1) is constantly exposed and uncovered so that a bill can be pressed directly down into engagement

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therewith (bill 68 can be pressed directly down into engagement with the upper side of the lower plate 82, Parish, Fig. 1).

Claim 24. Parish in view of Vogt discloses a gaming machine comprising a container to store foreign matter (see rejection for claim 1). The container store foreign matter which passes through the bill guide plate (82 in Fig. 1) wherein it extends from the front of the door (see Fig. 1). However Parish in view of Vogt fails to teach the container comprises a bottle-shaped container. Nevertheless, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Parish in view of Vogt and incorporate a bottle-shaped container since the court held that changing the shape of an invention involves only routine skill in the art. *In re Daily*, 149 USPQ 47.

Response to Arguments

Applicant's arguments filed 6/12/08 have been fully considered but they are not persuasive.

Regarding 35 USC 112 first paragraph rejection, Applicant has amended the specification to incorporate description of the shoulder. However applicant's original specification does not disclose the pins are located proximate to a shoulder. The amendment disclose "the pins are located proximate a shoulder (no numeral) in a manner illustrated in Fig. 8". Fig. 8 does not explicitly nor implicitly illustrate a shoulder.

It is not clear what the shoulder (non numeral) element is referred to in the figure. Thus the 35 USC 112 first paragraph rejection is maintained.

Regarding claims 1-8, 10-11, 13-21, rejected under 35 USC 103 (a) as being unpatentable over Parish in view of Vogt, it appears that applicant's argument is that the absence of a container in Parish's reference, it is implied that the omission of a container is intentional, and therefore done by design. However, speculating on the intention of Parish is irrelevant to whether it would have been obvious to modify Parish's invention to incorporate a container. What is relevant is that Parish discloses a bill acceptor that separates foreign matter from the bill. Vogt discloses a container to collect foreign matter. It would have been obvious to modify Parish's bill acceptor that separates foreign matter from the bill and incorporate a container as taught by Vogt in order to collect the foreign matter.

Additionally, applicant argues that due to the different structures in Parish's and Vogt's design, it would not be obvious to incorporate features of Vogt's invention into Parish's invention. However the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference (See MPEP 2145 section III). One of ordinary skilled in the art would know how to modify the Parish's invention accordingly to incorporate the features of Vogt.

Regarding claim 16, applicant argues the modifying the shape of the container teaches away from the prior art. It is clear that that shape of the container from the prior art is different from the shape of the claimed invention. However, changing the shape of the container does not teach away from the prior art in which bill acceptor that

separates foreign matter and collects foreign matter in a container. Changing the shape of container, will still allow the bill acceptor to separate foreign matter and collect foreign matter in a container. Thus modifying the shape of the container does not teach away from the prior art. Furthermore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Parish in view of Vogt and incorporate a certain shape of container since the court held that changing the shape of an invention involves only routine skill in the art. *In re Daily*, 149 USPQ 47.

Arguments in page 9-11 appear to be address the newly added claims 22-24. The limitations of claims 22-24 have been addressed in the rejections above (see rejection for claims 22-24).

Double Patenting rejection. The double patenting rejection is maintained. As discussed above, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference (See MPEP 2145 section III). One of ordinary skilled in the art would know how to modify in invention accordingly. Furthermore, in the double patenting rejection, the Vogt reference is relied upon for a container. The disclosure of how the device could be cleaned to remove contaminants other than liquids is irrelevant to whether it would have been obvious to one of ordinary skilled to modify the copending application and incorporate a container as taught by Vogt.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

JHY